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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,818	12/05/2003	Christopher Tzann-en Szeto	YHOOP009	8561

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EXAMINER

BAROT, BHARAT

ART UNIT PAPER NUMBER

2155

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/729,818

Applicant(s)

SZETO ET AL.

Examiner

Bharat N. Barot

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/12/05, 11/17/05, 12/20/05</u> . | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO REQUEST FOR CONTINUED EXAMINATION (RCE)

1. New claims 42-66 remain for further examination.

The new grounds of rejection

2. Applicants' presented new claims 42-66 and also presented arguments with respect to claim 42 and request for continued examination (RCE) filed on November 01, 2005 have been fully considered but they are deemed to be moot in view of the new grounds of rejection.

Claim Rejections - 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 42-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verma et al (U.S. Patent No. 6,564,246) in view of Ludwig et al (U.S. Patent No. 6,237,025).

5. As to claim 42, Verma et al teach a method of sharing information in an instant messaging environment (See abstract; and figure 2), comprising the computer-implemented steps of: providing an instant messaging interface for a first instant messaging application (12) and a second instant messaging application (16); the instant messaging interface for the first instant messaging application includes a first region (123) and a second region (121) and the instant messaging interface for the second instant messaging application includes a third region (162) and a fourth region (161); all content (101) entered in the second region is displayed in real-time in the fourth region and in the fourth region is displayed in real-time in the second region; and content in the first region (123) is not automatically displayed in the instant messaging interface for the second instant messaging application (figure 2-4; column 10 lines 7-51; and column 10 line 52 to column 11 line 19).

However, Verma et al do not teach the steps of: receiving user input that selects a portion of content displayed within the first region of the instant messaging interface of the first instant messaging application; in response to the receiving, storing data that reflects the selected portion of content; and without affecting content displayed in the second and fourth regions, causing information to be displayed in the third region based on the stored data, the data displayed in the third region is related to the portion of content selected in the first region.

Ludwing et al teach a method of sharing information in an instant messaging environment (See abstract; and figures 1-2s), comprising the computer-implemented steps of: providing an instant messaging interface for a instant messaging application; the instant messaging interface includes a first region and a second region; and sharing content entered in the first region and the second region with the other instant messaging application (figures 1-2s; column 5 line 63 to column 6 line 19; and column 8 line 41 to column 10 line 15); content in the first region is not automatically displayed in the instant messaging interface for the other instant messaging application; receiving user input that selects a portion of content displayed within the first region of the instant messaging interface of the first instant messaging application; in response to the receiving, storing data that reflects the selected portion of content; and without affecting content displayed in the second and fourth regions, causing information to be displayed in the third region based on the stored data, the data displayed in the third region is related to the portion of content selected in the first region (figures 2s, 20, and 28; column 18 line to column 19 line 46; and column 26 line 25 to column 27 line 52).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Verma et al by incorporating the teaching of Ludwing et al as stated above for sharing information in an instant messaging environment because it would have efficiently maintained and controlled instant messaging application activities and provided the capabilities required for maximally effective collaboration, and are not cost-effective.

6. As to claim 43, Verma et al teach that storing data comprises storing data locally on the device running the first instant messaging application (figure 1; and column 9 line 49 to column 10 line 6).

7. As to claims 44-47, Verma et al teach that displaying search results in the second region of the instant messaging interface of the first instant messaging application based on search information entered by a user of the first instant messaging application, wherein the step of receiving input from the user of the first instant messaging application that selects a portion of content displayed within the second region of the instant messaging interface of the first instant messaging application comprises receiving input from the user that selects all of the displayed search results or a portion of the displayed search results, and wherein the step of storing data that indicates a portion of content that is to be shared comprises storing the search information entered by the user (figures 2-4; and column 10 line 7 to column 11 line 19).

8. As to claim 48, Verma et al teach that sending a notification from the first instant messaging application to the second instant messaging application that the stored data has been updated (figure 7; and column 11 line 57 to column 12 line 12).

9. As to claim 49, Verma et al teach that storing data that indicates a portion of content that is to be shared in substantially real-time additionally comprises storing data that indicates online purchasing information related to the selected portion of content (figures 5-7; and column 11 line 20 to column 12 line 12).

10. As to claims 50-51, Verma et al disclose that the content is a list of categories; and teach that receiving from the user of the first instant messaging application a list of users permitted to share content, wherein the user of the second instant messaging application is in the list of users (figures 1-2 and 5-7; column 8 lines 36-64; column 9 line 62 to column 10 line 51; and column 11 line 20 to column 12 line 12).

11. As to claims 52-53, above remarks rejecting claim 42 equally apply here. Additionally, Ludwing et al teach that method of claim 42 implemented or used in more than two instant messaging applications environment and also select more than one portions from the one instant messaging application to share with more than two instant messaging applications (see figures 1-2s, 8s, 20, 31s, and 35-42). Duplicate parts/steps for multiple effects is generally not given patentable weight or would have been obvious for improvements.

12. As to claims 54-65, they are also rejected for the same reasons set forth to rejecting claims 42-53 above, since claims 54-65 are merely a program product for the method of operation defined in the claims 42-53.

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13. As to claim 66, it is also rejected for the same reasons set forth to rejecting claim 42 above, since claim 66 is merely an apparatus for the method of operation defined in the claim 42.

Response to Arguments

14. Applicant's arguments have been fully considered. The examiner has attempted to answer (response) to the remarks (arguments) in the body of the Office action.

Contact Information

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Bharat Barot** whose Telephone Number is **(571) 272-3979**. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM. Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Saleh Najjar**, can be reached at **(571) 272-4006**.

Patent Examiner Bharat Barot

Art Unit 2155

January 06, 2006

Bharat Barot.
BHARAT BAROT
PRIMARY EXAMINER